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09/465,708	12/17/1999	FUMIKO SEMBA	FUJI-16.863	9208

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HELFGOTT & KARAS P C  
EMPIRE STATE BUILDING  
60TH FLOOR  
NEW YORK, NY 10118

EXAMINER

AL AUBAIDI, RASHA S

ART UNIT

PAPER NUMBER

2642

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/465,708

Applicant(s)

SEMBA ET AL.

Examiner

Rasha S AL-Aubaidi

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1,3,7,and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Nhaissi (US Pat # 6,381,315).

Regarding claim 1, Nhaissi teaches a part, which receives (computer 6, see Fig.1, col. 8, lines 41-57) a number of a telephone terminal of a called party; and a part, which, selects (computer 6, see Fig.1) a network from a plurality of connectable networks including the Internet with said number and connects to network.

Claim 3 is rejected for the same reason with respect to calim1.

Regarding claim 7, Nhaissi teaches a part which originates a call to said telephone terminal after switching from a route via the Internet to a route via another network when said route via the Internet is busy (see col.12, lines 14-27).

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Claim 8 is rejected for the same reason with respect to claim 7.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2,4, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nhaissi in view of Leipow (US Pat #6,148,067).

Nhaissi teaches a method and apparatus for selecting the least cost routing as described in the claims above.

However, Nhaissi does not teach a predetermined operation by a caller during a call via the Internet to connect the call via another network.

Leipow teaches an access network communication unit and a voice bridge processor between users in a chat room or "virtual room" which, read as "call via the internet".

Regarding claims 2 and 4, Leipow teaches a part which calls said telephone terminal via a network other than the Internet and connects to said telephone terminal in response to a predetermined operation (entering the ID of the other party with whom the user desire to talk) by a caller during a call via the Internet, see col.4, lines 12-60.

Regarding claim 9, Leipow teaches a computer readable medium comprising: program code means for receiving a number of a telephone terminal of a called party; program code means for selecting a network from a plurality of connectable networks including the Internet with said number and connecting to said network; and program code means for calling said telephone terminal via a network other than the Internet and connecting to said network in response to a predetermined operation (which has been discussed above) by a caller during a call via the Internet. See col. 4, lines 12-60, and col. 6, lines 13-64.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature of a predetermined operation which taught by Leipow in Nhaissi system. This provides the user with the option of switching a call from the Internet to another network such as the telephone network, when, for example, the quality of the call via the Internet is poor.

***Claim Rejections - 35 USC § 103***

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3. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nhaissi in view of Partridge III (US Pat # 5,550,915).

Nhaissi features <sup>have</sup> ~~has~~ been taught and discussed in the claims above.

Nhaissi does not teach calling a terminal via a network other than the Internet and connecting to telephone terminal in response to dialing a special number or pushing a button after an on-hook operation.

Regarding claims 5 and 6, Partridge teaches the exchange comprising: a part which calls said telephone terminal via a network other than the Internet and connects to said telephone terminal in response to dialing a special number or pushing a button (which reads as the 103-1, 103-2, 103-03 and 103-04 as shown in Fig. 1) after an on-hook operation by a caller during a call via the Internet (see col. 3, lines 42-63, and col. 5, lines 33-49).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature of calling a terminal via a network and connecting to telephone terminal or pushing a button after an on-hook operation that taught by Partridge in the Nhaissi system in order to enable the user to take advantage of the speed dialing feature as taught by Partridge.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3,7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al (US Pat # 5,995,602).

Regarding claim 1, Johnson teaches a part, which receives (Moderator 1, which reads on a computer, see Fig.1, col. 3, lines 45-53) a number of a telephone terminal of a called party; and a part, which, selects (Moderator 1, see Fig.1) a network from a plurality of connectable networks including the Internet with said number and connects to network.

Claim 3 is rejected for the same reason with respect to claim 1.

Regarding claim 7, Nhaissi teaches a part, which originates a call to said telephone terminal after switching from a route via the Internet to a route via another network when said route via the Internet is busy (see col.8, lines 64-67, col.5, l-8).

Claim 8 is rejected for the same reason with respect to claim 7.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rasha S AL-Aubaidi whose telephone number is (703) 605-5145. The examiner can normally be reached on Monday-Friday from 8:30 am to 7:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

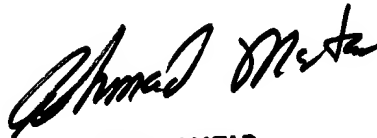
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Examiner

Rasha S Al-Aubaidi

05-01-2002



AHMAD MATAR  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600